

REMARKS

In the final Office Action mailed February 8, 2005, claims 1-4, 7-10 and 13-16 were rejected under 35 USC §102(e) over Tsuei et al. Reconsideration and withdrawal of these rejections are respectfully requested.

At the outset, Applicant's representative wishes to thank Examiner Gilligan for the detailed analysis in the Advisory Action of August 5, 2005. The amendments to the claims and the remarks hereunder specifically address the issues raised therein.

Anticipation requires that each claim element be taught by the applied reference. Should the applied reference be shown to lack a teaching of one or more of the claimed elements, the anticipation rejection should be withdrawn.

It is respectfully submitted that Tsuei et al. do not teach claim 1's steps of:

... the method comprising the steps of:

the bank generating the requested package code, the package code being devoid of delivery address information;

the bank sending the generated package code to the vendor, wherein the bank does not send any delivery address information for the package to the vendor; and

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and

the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper to enable the shipper...

As shown above, it is the bank that carries out the foregoing steps, as explicitly recited in the claimed steps – not only in the preamble. As claimed, the bank generates the requested package code, it is the bank that sends the generated package code to the vendor, it is the bank that generates a shipping identifier that is associated with the generated package code, and it is the bank

that sends the generated shipping identifier and the retrieved address to the shipper. It is respectfully submitted that the Tsuei et al. reference does not teach these claimed steps.

Kindly recall that amended claim 1 requires that the bank carry out the steps of:

the bank generating the requested package code, ...;
the bank sending the generated package code to the vendor, ...

In Tsuei et al., it is the customer, and not the bank as claimed, that provides the Private Mail code to the merchant, as explicitly stated in paragraph [0208]:

[0208] ...The customer provides the Private Mail code to a merchant to enable the merchant to ship mail or parcels to the customer...

In Tsuei et al., therefore, the Private Mail code is provided by the customer to the merchant. In contrast, the claimed invention requires that a bank send the generated package code to the vendor. In Tsuei et al., the customer must have previously been provided with the Private Mail code, because the customer later provides that Private Mail code to the merchant. In the claimed embodiment, the customer is not provided with any Private Mail code. Indeed, in claim 1, it is the merchant (and not the customer) that is sent the bank-generated package code. Tsuei et al. does not teach or show that the merchant is provided with a bank generated package code by the bank. In Tsuei et al., the Private Mail code is given to the customer, who then supplies that Private Mail code to the merchant as the "ship to" address:

[0208] ...The customer provides the Private Mail code to a merchant to enable the merchant to ship mail or parcels to the customer. Using the example of an online purchase, the customer orders from the merchant in the usual way, but supplies only the Private Mail code as the "ship to" address...

The above detailed and claimed distinctions, taken alone, are sufficient to obviate the 35 USC §102(e) rejections. However, claim 1 continues with the bank carrying out a step of:

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and

Nowhere in Tsuei et al. does a bank, or any other party, generate a shipping identifier for the package that is associated with the generated package code. According to the claimed embodiment, there are three entities that are provided to the shipper: the bank provided package code, the bank provided shipping identifier and the bank provided stored address associated with the customer's account at the bank. Tsuei et al. does not teach or show any such shipping identifier for the package that is associated with the generated package code or any step of sending such to a shipper. In Tsuei et al., the only code or identifier provided to the shipper is the Private Mail code, which is supplied by the customer. According to the claimed embodiment, however, the shipper is sent both the generated package code and the generated shipping identifier that is associated with the generated package code.

In the Advisory Action mailed August 5, 2005, stated that the customer's address ultimately originates from the bank. Notwithstanding this assertion, to anticipate the claims, the bank in Tsuei et al. must be disclosed to carry out each of the recited steps, which it does not, as detailed above.

In the Advisory Action, the Examiner states that the PMMC of Tsuei et al. "generates a shipping identifier for the package based upon the package code." However, it is respectfully submitted that Tsuei et al. teaches nothing of the sort.

All instances of PMMC in the written portion of the description of the Tsuei et al. reference are reproduced and underlined below, for the Examiner's convenience:

One embodiment of such generic private mail service is depicted in FIG. 26. Initially, the consumer (301) registers with the private mail service ("PMS" 310), which can be conceptually divided into Private Mail Administration

Service ("PMAS" 311) and Private Mail Mapping Center ("PMMC" 312). PMAC is responsible for customer registration and subscription, billing, assignment of Private Mail codes, and customer service functions such as changes to delivery address, modifying account data, canceling subscriptions, as well as various other account maintenance functions.

In order to modify any subscription data, e.g., name or address, the customer will need to authenticate his identity. The authentication process may use a personal identification number (PIN), password, digital certificate, written signature, or other means of positive identification. Customer service is preferably available for PMAC activities, so that account changes and customer issues may be resolved quickly after a customer's registration or other relevant transaction is processed by the PMAC, the delivery address and associated Private Mailing code is added to the PMMC and stored in its database (313). If PMAC and PMMC are physically separate from each other, a secure communication link (314) should be established between them for information transfer. All updates to the PMMC database are preferable made in real or quasi real time. A "live" data backup in another physical location (not pictured) is preferably maintained, so that the data is redundantly stored and service need not be interrupted if PMMC fail or PMAC fail.

Generally, consumers will not be able to update the PMMC database directly, but will have to identify themselves and follow the registration and information updating protocol established by the PMAC, as previously described. The specific update functions that consumers will be able to perform include, but are not limited to creation of a new Private Mail code, deletion of an unwanted Private Mail code, and changes to the delivery address associated with a Private Mail code.

PMMC's main function is to provide shippers with the delivery address information associated with the Private Mail code. It includes a secure interface to allow the shippers to look up the delivery address associated with a Private Mail code. Additionally, the PMMC might handle administration functions associated with the shippers, such as access control to the PMMC, usage, and billing or payment of any transaction fees or service charges.

The PMMC is preferably a high availability service designed for continuous 24/7 operations. This will be achieved through the use of redundant equipment, multiple physical data center locations, robust disaster recovery methods, and other means designed to prevent service interruptions. PMMC's database is highly secure, accessible only to authorized users. At a minimum, it maintains the following data: Private Mail code, physical delivery address, authorized users, and audit trail with date/time/user associated with each access.

Shippers' access to the PMMC database is restricted to lookup operations that map a Private Mail code to a delivery address, and to access to certain administrative functions of the PMAC that are used for troubleshooting, problem resolution, and account maintenance.

FIG. 28 shows a flowchart of a typical transaction, which, of course, need not be a purchase, but instead may be any interaction that results in a mailing or shipping. The customer provides the Private Mail code to a merchant to enable the merchant to ship mail or parcels to the customer. Using the example of an online purchase, the customer orders from the

merchant in the usual way, but supplies only the Private Mail code as the "ship to" address. The merchant then fills the order and labels it for shipment using only the Private Mail code. The parcel is picked up by the shipper. The shipper, a Private Mail partner, accesses the PMMC to map the Private Mail code on the parcel to the customer's physical delivery address. Once the mapping is completed, the shipper relabels the parcel, either physically or electronically, with the delivery address and completes the delivery using conventional means.

As the Office can plainly see, the PMMC does not generate a shipping identifier for the package based on the package code (or based on anything else). What the PMMC does, in Tsuei et al., is to respond to requests for access to the PMMC database 313 by the shippers and provides them with the customer's delivery address for the package. In Tsuei et al., the shipper must request the customer's address from the PMMC by providing the PMMC with the Private Mail code. According to the claimed embodiment, the bank sends the shipping identifier and the customer's address to then shipper. This occurs without the shipper making any requests. IN turn, this enables the shipper, as claimed:

...after picking up the package for shipment from the vendor, to associate the package code sent to the vendor with the shipping identifier, to identify the associated address as the delivery address of the package, and to ship the package directly from the vendor to the delivery address without divulging any delivery address for the package to the vendor.

In contrast, Tsuei et al. calls for the shipper to be provided with the Private mail code when the package is picked up, to contact the PMMC, to give the PMMC the Private Mail code and request the delivery address, whereupon the PMMC maps the provided Private Mail code to the customer's delivery address, which is then provided to the shipper. Note that the claim only enables the shipper to do these things. All of the claimed steps in claim 1 are, in fact, carried out by the bank. The result of these claimed steps is that the shipper is enabled to do what is recited in the last clause of amended claim 1, nothing more.

The Examiner's kind attention is now drawn to claim 7, which recites sequential steps of:

the shipper receiving a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto but no delivery address;

the shipper receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account, the delivery address being associated with the customer's account at the bank;

the shipper picking up the package from the vendor;

In Tsuei et al., the shipper does not receive a shipping identifier from a bank. In Tsuei et al., the shipper picks up a package with a customer-provided Private Mail code. Then the shipper contacts the PMMC, gives the Private Mail code to the PMMC, which then responds by providing the shipper with the customer's address. Therefore, claim 7 is not anticipated.

Indeed, in the embodiment of claim 7, the shipper only picks up the package from the vendor after having received both the request to pick up the package and the shipping identifier and delivery address from the bank. In direct contrast, Tsuei et al. teaches an approach in which the shipper is not provided with any information prior to picking up the package:

[0208] ... The merchant then fills the order and labels it for shipment using only the Private Mail code. The parcel is picked up by the shipper. The shipper, a Private Mail partner, accesses the PMMC to map the Private Mail code on the parcel to the customer's physical delivery address. Once the mapping is completed, the shipper relabels the parcel, either physically or electronically, with the delivery address and completes the delivery using conventional means.

and must access the PMMC (Private Mail Mapping Center) to obtain the physical delivery address. There is no disclosure in Tsuei et al., of the shipper a) receiving a request to pick up a package from a bank and b) receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account. The claimed items a) and b) are nowhere disclosed in Tsuei et al., and much less disclosed to occur before the shipper picks up the

package to be shipped. This lack of teaching of claimed steps is believed to be fatal to the Office's 102(e) rejection of claim 7 and of its dependent claims.

Turning now to independent claim 13, therein it is recited:

the vendor sending a request for a package code to a bank at which the customer maintains an account and an electronic draft for payment of the goods on behalf of the customer;
the vendor receiving payment on the draft and the package code from the bank only if the customer is authenticated by the bank and bank-imposed constraints are satisfied, the package code being devoid of delivery address information;
the vendor preparing the package for shipment by the shipper...

Nowhere in Tsuei et al. does a merchant or vendor send an electronic draft and a package code to a bank at which the customer maintains an account. In Tsuei et al., the merchant may be paid out of the customer's anonymous Alias account (or credit card) and is only given the customer's Private Mail code, which Private Mail code is then applied to the package to be shipped. Tsuei et al. does not disclose any method wherein the vendor or merchant sends a request for a package code. In Tsuei et al., the Private Mail code is given to the merchant by the customer as the "ship to" address, as excerpted above. In this regard, the Examiner's kind attention is respectfully drawn to the excerpted description of Fig. 28 of Tsuei et al., above:

The customer provides the Private Mail code to a merchant to enable the merchant to ship mail or parcels to the customer.

Therefore, it is clearly the customer and not the bank that provides the merchant with the Private Mail code. The claimed embodiment, however, requires the vendor to request a package code from the bank. Tsuei et al., therefore, does not teach or suggest the embodiment of claim 13. The above claimed features are nowhere taught or disclosed by Tsuei et al. Consequently, the 35 USC §102(e) rejection of the claims must be withdrawn.

Applicant's attorney, therefore, respectfully submits that all remaining claims are allowable and, therefore, the present application is in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

Respectfully submitted,

Date: Oct. 6, 2005

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